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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of)	
Jay Paul Drummond, et al.)	
)	
Serial No.: 09/077,337)	Art Unit 3624
)	
Confirmation No.: 5900)	
)	
Filed: May 27, 1998)	Patent Examiner
)	Kelly Scaggs Campen
)	
Title: Automated Banking Machine)	
Apparatus and System)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 1.193(b)

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 1.193(b), in triplicate, concerning the above-referenced Application.

REMARKS

The Examiner's Answer ("Answer") dated December 11, 2003 is acknowledged. The Appellants respectfully submit that the rejections set forth in the Answer have already been fully addressed in the Second Supplemental Appeal Brief filed September 19, 2003 ("Appeal Brief").

Grouping of Claims

The Answer (at page 2) alleges that

"The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the claims as listed by the appellant are not separately patentable."

The Appellants respectfully disagree. The Grouping of Claims section in the Appeal Brief is correct. 37 C.F.R. § 1.192(c)(7) requires Appellants to (A) state that the claims do not stand or fall together, and (B) present arguments why the claims are believed to be separately patentable. The Appellants respectfully submit that the Appeal Brief complies with 37 C.F.R. § 1.192(c)(7).

The Appeal Brief (at page 6) includes a Grouping of Claims section which includes the statement that "No groups of claims stand or fall together." Thus, the Appeal Brief includes a proper statement that the claims do not stand or fall together.

The Appeal Brief (in the "Argument" section thereof beginning on page 7) also provides reasons in support of why the claims do not stand or fall together. That is, the Appeal Brief presents arguments why each of the claims is separately patentable. The Appeal Brief presents

for each respective separate claim a corresponding respective separate argument as to why the claim is patentable over the rejection applied thereto. The Appeal Brief provides reasons how each claim recites additional features of the invention which distinguishes the claim over every other pending claim, and provides reasons how each of the claims recites at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claims.

Thus, the Appeal Brief includes both a proper statement that the claims do not stand or fall together and arguments why each of the claims is separately patentable. It follows that the Answer incorrectly characterizes the Grouping of Claims section of the Appeal Brief.

Furthermore, where an Appeal Brief includes only one of either (A) a statement that the claims do not stand or fall together or (B) presents arguments why the claims are separately patentable, then the Appellants are to be notified of a noncompliance as per 37 C.F.R. § 1.192(d). Note MPEP § 1206 (August 2001 version at page 1200-11, col. 1, first paragraph). As previously discussed, the Appeal Brief includes a statement that the claims do not stand or fall together. Appellants were not notified of any noncompliance. Nor were Appellants given any appropriate time period to correct any alleged defects in accordance with 37 C.F.R. § 1.192(d). Thus, it must be concluded that the Appeal Brief (including the Grouping of Claims section thereof) is in compliance with 37 C.F.R. § 1.192(c). Appellants respectfully request that the Answer's incorrect assertions regarding the Grouping of Claims section of the Appeal Brief be disregarded.

References of Record

This section of the Answer provides a “listing of the references of record relied on” in the grounds of rejection. Note MPEP § 1208 (August 2001 version at page 1200-19, col. 1, first paragraph). Appellants acknowledge that the only references listed are LA Times and Infoworld. That is, the Office’s withdrawal of the previous reliance on *Anderson, et al.* (US 5,706,442) in the grounds of rejection is acknowledged.

Response to Argument

The Answer includes a “Response to Argument” section beginning on page 3. The Office’s comments in this section do not appear relevant to the merits of the recited claim language, nor to Appellants’ respective arguments. The comments in this section do not address the specific issues of record.

It is unclear how the Office’s comment (on page 3) regarding “Internet Explorer” is applicable to the claimed subject matter. Appellants respectfully decline to speculate. A prior art teaching describing “Internet Explorer” is not of record. Furthermore, the Action is silent as to a prior art teaching of “Internet Explorer” relating to the recited automated banking machine, or to the dispensing of a sheet therefrom (e.g., claim 31). Also, it appears that the Office’s reference to “Internet Explorer” occurs for the first time in the Answer.

The Answer next refers to the alleged “inherent” ability of the ATM in LA Times. The Appeal Brief (e.g., pages 15-17) already addressed this issue. As previously discussed, the assertions of inherency by the Office are pure speculation, and are not based on any evidence in

the record. The Office has failed to prove through citation to prior art that the features alleged to be inherent in LA Times are “necessarily present.” An assertion of prior art knowledge not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). The determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Appellants respectfully submit that the rejections are not valid because they are based on mere assertions and not proper evidence of record.

The Answer’s next comment regarding the use of “Official Notice” is not appropriate. The “Official Notice” has been asserted by the Office without documentary evidence. The Appellants respectfully submit that the “Official Notice”, on which the rejections rely, is not in compliance with MPEP § 2144.03. The Appellants are not required to prove patentability. On the contrary, the burden is on the Office to establish a *prima facie* case of obviousness under the law. The Office is not permitted to rely on unsupported assertions of “Official Notice” as the basis for rejecting claims (which is the present situation), and when challenged is required to establish such assertions in the proper manner through citation to prior art documentary evidence. The Appellants have continued to challenge each assertion of “Official Notice” throughout the prosecution history. After five non-final rejections the Office still has not produced any prior art evidence in the record to support the assertions (or the substantial evidence test). The determination of patentability must be based on concrete evidence of record, not on unsubstantiated assertions presented under the guise of an “Official Notice” (which is the present situation). *In re Zurko*, supra. *In re Lee*, supra.

The Answer (on page 4) next refers to an argument allegedly made by Appellants that “the reference patents are old.” However, the Answer is silent as to where the alleged argument regarding the age of patents is presented in the Appeal Brief. Nor is there any indication that the argument attributed to Appellants was presented, especially in the Appeal Brief. Contrarily, the references are too young with regard to the filed Declaration (which issue is discussed in more detail beginning on page 11 of the Appeal Brief).

The Appellants respectfully traverse the Answer’s final remarks (on page 4) regarding hindsight reasoning and attacking references individually. The remarks are without basis. They also do not address the merits of the application, but rather avoid the issues of record.

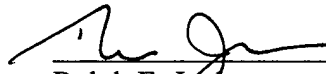
Additional Comments

Submitted herewith is a request that the previously filed Petition for Withdrawal of a Restriction Requirement (filed by Appellants on July 10, 2001) be withdrawn from consideration. Thus, no petitions should be pending.

CONCLUSION

Each of Appellants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in the applied prior art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features thereof so as to produce the recited invention. For these reasons it is respectfully submitted that the claims are allowable.

Respectfully submitted,



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